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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.              |
|---|-------------|----------------------|---------------------|-------------------------------|
| 10/021,029  | 12/19/2001  | Kazunori Shimada     | 03863.0055          | 9552                          |
| 7590  | 10/28/2003  |                      |                     |                               |
| Finnegan, Henderson, Farabow,<br>Garrett & Dunner, L.L.P.<br>1300 I Street, N.W.<br>Washington, DC 20005-3315 |             |                      |                     | EXAMINER<br>MENON, KRISHNAN S |
|   |             |                      |                     | ART UNIT<br>1723 PAPER NUMBER |

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |                   |  |
|------------------------------|------------------------------|-------------------|--|
| <b>Office Action Summary</b> | Application No.              | Applicant(s)      |  |
|                              | 10/021,029                   | SHIMADA, KAZUNORI |  |
|                              | Examiner<br>Krishnan S Menon | Art Unit<br>1723  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 October 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9,10,13,14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9,10,13,14,17 and 18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 9,10,13,14,17 and 18 are pending

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 9,10,13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huder (US 5,714,065) in view of Markonius (US 5,861,430).

Claim 9: Huder teaches a water insoluble antibacterial filter (Fig 1 col 3 lines 3-10) comprising water introduction unit (11-Fig 1), water purifier unit (7,8), water discharge unit (13), flow passage switching valve (12) disposed between the water introduction and water purifier units for switching flow depending on whether water is to be purified or not, water purifier unit containing plural kinds of filter members in water flow direction (7,8), any one or more of the layers mixed with an antibacterial material in a water insoluble base (silver in quartz) (col 3 lines 2-5). The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as

an antimicrobial component. It would be obvious to one of ordinary skill in the art at the time of invention to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col 2 lines 5-8) and its compatibility with different types of carriers (col 7 lines 45-67).

Claim 10: The base members are ceramic (see ref to ceramics in the text) or an ore (quartz) (see col 2 line-30 – col 3 line30, especially col 3 lines 2-5)

Claim 13: Huder teaches a water insoluble antibacterial filter (Fig 1 col 3 lines 3-10) comprising water introduction unit (11-Fig 1), water purifier unit (7,8), water discharge unit (13), wherein the antimicrobial agent is disposed in a member constituting a flow passage, the ceramic filter unit (7 and 8-fig 1). The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as an antimicrobial component. It would be obvious to one of ordinary skill in the art to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col 2 lines 5-8) and its compatibility with different types of carriers (col 7 lines 45-67).

The base member is ceramic (see ref to ceramics in the text) or an ore (quartz) as in claim 14 (col 3 lines 3-10).

2. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennemann (US 5,829,645) in view of Shibuya et al (6,153,228).

Hennemann teaches an antibacterial container having antibacterial agents coated on the various inner wall surfaces as in claim 17 (col 2 line 1 – col 3 line 48). Hennemann does not teach a propolis component as the antibacterial agent. Shibuya teaches use of a propolis component as an anti bacterial agent for application on various surfaces like ceramics, ores, containers etc, and include

practically any surface or application one could think of (col 8 lines 17- 65). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Shibuya in the teaching of Hennemann for the antibacterial container because of the remarkable properties of propolis components as taught by Shibuya (see col 8 lines 17-18).

Claim 18: The base member can be ceramic or an ore as in Shibuya.

***Response to Arguments***

Applicant's arguments filed 8/8/03 have been fully considered but they are not persuasive.

In response to applicant's argument that, "Even if the propolis component of Markonius could be substituted for the antimicrobial agent of Huder, which Applicant submits is improper, the Examiner has failed at least to establish an element of the instant claims, a propolis component "contained in, or adhered to, a water-insoluble base member." Neither reference alone or their combination teaches or suggests this element of Applicant's claims", and "... the reference combination still fails to teach or suggest an element of claim 1 3, "an antibacterial member constituted such that a propolis component is contained in, or adhered to, a water-insoluble base member", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding the Tudor ref, claim 3 was cancelled, and therefore, it is moot. Rest of the arguments are covered in the rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon  
Patent Examiner

*Joseph Drodge*  
JOSEPH DRODGE  
PRIMARY EXAMINER